

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-17 are now present in this application. Claims 1 and 7 are independent.

Amendments have been made to claims 1-5, 12, 14 and 16. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. §119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. §119, and receipt of the certified priority document.

Rejections under 35 U.S.C. §103

Claims 1-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,567,011 to Young et al. (hereinafter, "Young") in view of U.S. Patent 6,469,633 to Wachter. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Applicants respectfully submits that neither Young nor Wachter discloses or suggests the claimed invention. For example, neither Young nor Wachter

discloses (1) "a controller that . . . produces a code conversion control signal" or (2) " a memory storing code conversion data" or (3) a code converter converting the code into a code corresponding to the verified peripheral media device using the code conversion data stored in the memory by responding to the code conversion control signal", or (4) the code converted outputting the converted code to the verified peripheral device through the communication port by responding to the output control signal."

The Office Action alleges, in general, that with respect to claim 1, Young "discloses all the claimed subject matter . . ." Then, on page 3, the Office Action admits that Young does not disclose the "claimed communication port to be connected with the peripheral media devices through a communication line" feature. These statements are completely contradictory and it is improper to base a rejection on a contradiction.

The Office Action also alleges that Young "produces a code conversion control signal and an output control signal is met by the receiver device 20 which configured to receive a selected input signal when the selected input signal from one of the input devices 30 and 40 (Fig. 1, col. 6, line 66 to col. 7, line 21).

Applicant respectfully disagrees. In col. 6, line 66 to col. 7, line 21, Young discloses that "the receiver 20 is adapted to receive a plurality of input signals" and that "[F]irst and second input devices 30 or 40 are connected to supply the

respective input signals to the received 20, and mode programming, preferably stored in memory is responsive to the mode keys, e.g., first input mode key 112, and programmed to activate corresponding modes.” Young says nothing about code conversion in this part of his disclosure, or in any other part of his disclosure.

Thus, Young fails to explicitly disclose “code conversion” or “producing a code conversion control signal.”

Perhaps the Office Action is relying on the doctrine of inherent disclosure, without saying so, although it should say so if it is relying on the doctrine of inherency.

Applicants respectfully submit that the Office Action provides no evidence why Young discloses “code conversion” or “producing a code conversion control signal” inherently.

Inherency may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

For the doctrine of inherency to apply, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to disclose a missing element if the missing element “is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Cont'l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20

USPQ2d 1746, 1749(Fed. Cir. 1991). Inherent disclosure requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599(Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Because Young does not explicitly disclose “a code conversion control signal” and because the office Action does not provide any evidence to explain why “a code conversion control signal” is necessarily disclosed, the Office Action has not made out a *prima facie* case of obviousness of the invention of claims 1-6, as alleged. Thus, the rejection is improper and should be withdrawn.

The Office Action then alleges that Young discloses the claimed code converter converting the code into a code corresponding to the verified peripheral media device by referring to col. 9, lines 3-40 of Young. However, the Office Action offers no explanation of why col. 9, lines 3-40 of Young discloses this claimed feature (recited in claims, 1-6, the corresponding code converting method being recited in claims 7-17). Applicants respectfully submit that col. 9, lines 3-40 of Young merely discloses how to verify a device ID code for a mode (col. 9, lines 8, ff.) and how to specify customized default device ID codes per mode (col. 9, lines 24, ff.) and, after a valid ID code has been set, how to lock and unlock the ID code for a specific mode (col. 9, lines 30, ff.). None of this disclosure of col. 9, lines 3-40 has anything to do with a code converter

converting code into a code corresponding to a verified peripheral media device, or the corresponding code converting method.

Thus, Young fails to disclose these claimed features.

As noted above, the Office Action further admits that Young does not explicitly disclose the claimed communication port to be connected with the peripheral media devices through a communication line.

In an attempt to remedy this admitted deficiency, the Office Action turns to Wachter, which controls a plurality of remote controllable electronic devices (RCEDs) using a central processing unit 2 to generate a control signal, e.g., an appropriate infrared code, to one or more appropriate RCEDs – see col. 6, lines 38-63, for example.

Initially, Applicants note that Wachter suffers from the same aforementioned deficiencies as does Young.

So, even if these two references were properly combined (which they are not for reasons stated below) they would not result in, or render obvious, the claimed invention recited in claims 1-17.

Moreover, the Office Action has not provided proper motivation to modify Young in view of Wachter. In the first place, Young works well without the need to incorporate a communication port to be connected with the peripheral media devices through a communication line and does not generate any converted code to be outputted to a media peripheral device through the communication port.

In the second place, Wachter's communication port is connected to a CPU which generates different signals to activate a plurality of RCEDs, whereas Young has only one remote 100, and has no need to use a CPU to activate his one remote 100. Therefore, there would be no motivation to add a communication port like the one in Wachter to Young. In the third place, the Office Action never states how the communication port added to Young would fit in with, and/or operate with Young's remote control that has no need for such a communication port or for a CPU that uses the communication port. This essential feature of an obviousness rejection is totally missing and is left solely to speculation. It is well settled that a rejection cannot be based on speculation. An Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. Denied.

The Office Action alleges that a skilled worker would be motivated to modify Young in view of Wachter is "in order to provide a control system for controlling multiple electronic components via a single user-operated remote control device." Evidence of motivation must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). This reason, urged by the Office, is

nothing more than a broad conclusionary statement about the teaching of all universal remotes and fails to constitute clear and particular evidence that would give a skilled worker the motivation to combine these disparate references.

A fair, balanced view of this rejection reveals that (1) it overlooks the fact that several claimed features of the invention recited in claims 1 and 7 are missing from both references, so that even if the references were properly combined, they would not render the claimed invention obvious, and (2) the fundamental differences between the references have not been taken into consideration in making the rejection, as they are required to be in view of Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), differences that teach away from combining the teachings of these two references and vitiate any motivation to combine these references, as alleged.

Accordingly, this rejection of claims 1-17 is improper and should be withdrawn.

With regard to dependent claims 2-6 and 8-17, Applicants submit that claims 2-6 depend, either directly or indirectly, from independent claim 1, and claims 8-17 depend, directly or indirectly from claim 7, which independent claims are allowable for the reasons set forth above, and therefore claims 2-6 and 8-17 are allowable based on their dependence respectively from claims 1 and 7. Reconsideration and allowance thereof are respectfully requested.

Amendments to the Specification and Claims

Applicants have made minor amendments to the specification to refer to correct drawing figures, and have amended claims to place them in better form grammatically. No new matter is involved, and the scope of the claims has not been narrowed in any way by these claim amendments.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Application No.: 09/942,710
Art Unit 2614

Attorney Docket No. 0465-0854P
Responsive to February 12, 2004 Office Action
Page 17

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone James T. Eller, Jr., Registration No. 39,538, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:

James T. Eller, Jr.

Reg. No.: 39,538

JTE/RJW:adt
gaw

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000